

REMARKS/ARGUMENTS

The present Amendment and Response comprises Applicant's reply to the USPTO Examiner's Final Office Action dated May 13, 2009. Claims 2, 10, and 21-25 were previously cancelled. Claims 26 and 28 are currently amended. Accordingly, Claims 1, 3-9, 11-20, and 26-35 are currently pending.

The amendments to Claims 26 and 28 are to clarify wording and are not overcome prior art. Applicant believes that no new matter has been added with regard to the claim amendments provided herein. Applicant does not disavow or disclaim any claims or subject matter with the claim amendments made herein, and the Applicant expressly reserves the right to prosecute the original claims or any unclaimed subject matter in one or more future filed continuing applications.

Reconsideration of the application is respectfully requested in view of the following remarks. Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, the Applicant requests that the Examiner carefully review any references discussed below to ensure that Applicant's understanding and discussion of the references, if any, is consistent with the Examiner's understanding. Also, Applicant's arguments related to each cited reference are not an admission that the cited references are, in fact, prior art.

I. Examiner's Cited References Are Not Prior Art Under 35 U.S.C. § 102(e)/103(a)

A. Applicant's date of invention is prior to the cited references

Affidavits or declarations filed under 37 C.F.R. 1.131 may be used "to antedate a reference that qualifies as prior art under 35 U.S.C. 102(e), where the reference has a prior art date under 35 U.S.C. 102(e) prior to applicant's effective filing date, and shows but does not claim the same patentable invention." See MPEP § 715 (I)(B). (Applicant does not admit that Grimm '044 shows the same invention as is being claimed in the present application. By way of example, Grimm '044 fails to disclose "at least one stabilizing projection to seat the body to the patient's bone or tissue" as claimed in Claim 1.)

Responsive to the rejections in the Final Office Action, Applicant herewith submits a Declaration Under 37 C.F.R. 1.131. More particularly, Applicant filed U.S. Provisional Patent Application No. 60/397,191 on July 18, 2002, entitled *Surgical Image Tracker Mounting Base Apparatus and Method of Use* ("Ritland '191"). Applicant's date of invention for the instant application is at least July 18, 2002, which pre-dates the application date of Grimm '305, which is December 20, 2002 (See Exhibit A, "Declaration Under 37 C.F.R. 1.131"; See also Ritland '191 attached to Exhibit A as Attachment A). In view of the foregoing, Applicant respectfully requests withdrawal of the 35 U.S.C. § 102(e)/103(a) rejections of pending Claims 1, 3-9, 11-20, and 26-35.

B. Additional rebuttal of the Grimm '044 and Grimm '305 based rejections

The Examiner has previously rejected Claims 1, 3-9, 11-20, and 26-35 under 35 U.S.C. § 102(e) as anticipated by, or alternatively, under § 103(a) as unpatentable over U.S. Pat. App. Pub. No. 2004/0172044 to Grimm et al. (Grimm '044). Applicant previously traversed

this rejection in his reply dated February 12, 2009 and incorporates the associated arguments herein by reference.

In the latest Office Action, the Examiner stated that:

Grimm et al. (2004/0172044) is prior art because the relevant subject matter finds full support (*sic*) in the prior filed application (2004/0122305). That Fig. 8 is not in the parent application does not prevent the use of Grimm et al. because the figures through figure 7 show the relevant subject matter. Claim (*sic*) 8 was cited in addition to other portions only for exemplification of related structure.

Office Action, May 13, 2009, pp. 3-4. Thus, the Examiner has maintained the use of Fig. 8 in the claim rejections. However, in view of the Declaration Under 37 C.F.R. 1.131 submitted herewith, Grimm '044 and Grimm '305 are not available as prior art to be cited against the claims of the present application.

Applicant submits a Request for Continued Examination and the requisite small entity fee for a Request for Continued Examination. Applicant believes no other fees are due for this submission. Please credit any over payment or debit any under payment to Deposit Account No. 08-2665.

Respectfully submitted,

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